**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of   :   Customer Number: 46320
                                             :
Gabriel MONTERO   :   Confirmation Number: 1061
                                             :
Application No.: 10/026,385   :   Group Art Unit: 2142
                                             :
Filed: December 21, 2001   :   Examiner: M. Meucci
                                             :
For: DYNAMIC PARTITIONING OF MESSAGE SYSTEM TOPICS

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

        This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S

ANSWER dated July 10, 2008.

        The Examiner's response to Appellant's arguments submitted in the Third Appeal Brief of

April 25, 2008, raises additional issues and underscores the factual and legal shortcomings in the

Examiner's rejection. In response, Appellant relies upon the arguments presented in the Third

Appeal Brief, and the arguments set forth below.

1   **<u>REMARKS</u>**

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3   <u>Claim 1</u>

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5   In response to the arguments presented in the Third Appeal Brief as to claim 1, the

6   Examiner initially asserted the following in the paragraph spanning pages 8 and 9 of the

7   Examiner's Answer:

8   In response to the above argument, the examiner points out that posting to a sub-topic
9   implies the selection of a "parent" topic, and that posting to the sub-topic implicitly includes
10   posting to the selected topic.
11
12   Appellant respectfully disagrees.   At the outset, Appellant notes that these assertions by the

13   Examiner appear to be factually-unsupported inherency arguments.   Inherency may not be

14   established by probabilities or possibilities. The mere fact that a certain thing <u>may</u> result from a

15   given set of circumstances is not sufficient to establish inherency.[1] To establish inherency, the

16   extrinsic evidence must make clear that the missing element must <u>necessarily be present</u> in the

17   thing described in the reference, and that the necessity of the feature's presence would be so

18   recognized by persons of ordinary skill.[2] Furthermore, reference is made to <u>ex parte Schricker,</u>[3]

19   in which the Honorable Board of Patent Appeals and Interferences stated the following:

20   However, when an examiner relies on inherency, it is incumbent on the examiner to point to the
21   "page and line" of the prior art which justifies an inherency theory. <u>Compare, In re Rijckaert,</u> 9
22   F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an
23   explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or
24   suggestion appears in the prior art); <u>In re Yates,</u> 663 F.2d 1054, 107, 211 USPQ 1149, 1151
25   (CCPA 1981).
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[1] <u>In re Rijckaert,</u> 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency
was based on what would result due to optimization of conditions, not what was necessarily present in the prior art);
<u>In re Oelrich,</u> 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).
[2] <u>Finnegan Corp. v. ITC,</u> 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); <u>In re Robertson,</u> 169 F.3d 743, 745 49
USPQ2d 1949, 1950-51 (Fed. Cir. 1999); <u>Continental Can Co. USA v. Monsanto Co.,</u> 20 USPQ 2d 1746 (Fed. Cir.
1991); <u>Ex parte Levy,</u> 17 USPQ2d 1461 (BPAI 1990).
[3] 56 USPQ2d 1723, 1725 (BPAI 2000).

1   The Examiner, however, did not discharge the burden. Instead, the Examiner's assertions are

2   entirely without factual support. Moreover, the Examiner's assertions are simply factually

3   unsupported.

4

5   A user, for example, could be presented solely with a list of sub-topics from which to

6   select. The selection of a sub-topic, however, does not establish that the user selected a "'parent'

7   topic," as asserted by the Examiner. Moreover, the Examiner's assertion that "posting to the sub-

8   topic implicitly includes posting to the selected topic" also neglects that in certain instances that

9   messages may only be posted to sub-topics, but not "parent" topics, in which the parent topic is

10   merely a way to classify sub-topics. In other instances, messages may only be posted to topics

11   and sub-topics are a way of further classifying the messages. Thus, the ability to post to a sub-

12   topic does not imply that ability to post to a selected topic, or vice-versa.

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14   The Examiner further asserted the following

15   [cite to column 12, lines 18-39 omitted]. This recitation from Knight not only teaches posting to a
16   single area, class, and subclass, but it goes further than the appellant's invention and is capable of
17   cross-referencing the posted messages in multiple subclasses. The user responds with a reply to a
18   particular subject matter area (lines 23-25 of column 12); the Knight invention tags the reply with
19   the area (topic) corresponding to the original post (lines 25-28 of column 12); and can additionally
20   subclassify messages by tagging them with company name or industry areas (lines 31-34 of
21   column 12), for example.
22

23   The passage cited by the Examiner (i.e., column 12, lines 18-39) does not teach posting to a

24   particular topic. Instead, this passage describes classifying a message. Specifically, there is a

25   difference between Appellant's claim, which recites posting to topic (e.g., a message is posted to

26   the topic "2008 election") and Knight's teaching that once a message has been received, the

27   message is classified. Within Knight, the message is not posted to a particular topic. Instead, the

28   message is classified by subject matter area/class/subclass.

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2   Of particular note is the Examiner's <u>failure to respond</u> to Appellant's arguments that the

3   passage cited by the Examiner to teach "messages are posted to and retrieved from individual

4   ones of said plurality of topics" is to what Knight considers to be the prior art. Thus, the

5   Examiner is improperly relying upon teachings from multiple references in rejecting the claims

6   under 35 U.S.C. § 102.

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8   <u>Claim 5</u>

9   In response to the arguments presented in the Third Appeal Brief as to claim 5, the

10   Examiner initially asserted the following in the paragraph spanning pages 9 and 10 of the

11   Examiner's Answer:

12   Appellant argues — Regarding claim 5, Knight does not teach "a plurality of threads of
13   execution." The appellant provides no support for this argument other than a statement disclosing
14   that Knight does not teach the limitation. The appellant's arguments fail to comply with 37 CFR
15   1.111(b) because they amount to a general allegation that the claims define a patentable invention
16   without specifically pointing out how the language of the claims patentably distinguishes them
17   from the references.
18
19   The Examiner's response is specious. The Examiner asserts that Appellant has failed to comply

20   with 37 C.F.R. § 1.111(b) when Appellant argued that the Examiner's cited passage (i.e., column

21   2, lines 2-4 and 13-15) do not teach limitations for which the Examiner is relying upon to teach.

22   If Appellant's arguments were a "general allegation," as asserted by the Examiner, the Examiner

23   should have explained why the Examiner's passage does teach these limitations. Instead, the

24   Examiner is now relying upon a different passage (see below) to allegedly teach these

25   limitations. As such, Appellant's position is that, despite the Examiner's assertion to the

26   contrary, Appellant was correct in asserting that the Examiner cited passage of column 2, lines 2-

27   4 and 13-15 does not teach all of the claimed limitations recited in claim 5.

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1   The Examiner then asserted the following:

2   The examiner points out that "threads of execution" as defined by the appellant's specification are
3   processes for communicating a message between the server and the subscriber. This is taught by
4   Knight on lines 22-27 of column 10 which disclose: "customized search robots 232 create logical
5   collections of messages based on individual user filtering criteria. To ensure that the independent
6   functionality provided by customized search robots 232 does not overwhelm server 220, only a
7   limited number of such robots are made available to subscribers." It is clear from this recitation
8   that multiple search robots can be used by multiple users simultaneously. Because a "limited
9   number of such robots are made available to subscribers," it is also clear that the system of Knight
10   processes multiple communications and thus is multi-threaded, based on the appellant's definition
11   of "threads of execution."
12

13   The Examiner's logic is misplaced. The fact that Knight may be capable of having multiple

14   threads running at the same time does not establish either, inherently (i.e., necessarily) or

15   explicitly, that Knight teaches the claimed "a plurality of threads of execution, each said thread

16   hosting a process for communicating a message between one of said subtopics in said at least one

17   message server and a message subscriber." The Examiner's cited passage does not exclude that

18   the processes for communicating a message described by Knight could all accomplished within a

19   single thread. Thus, the Examiner's analysis is flawed, and the Examiner has still failed to

20   establish that Knight identically discloses the claimed invention, as recited in claim 5, within the

21   meaning of 35 U.S.C. § 102.

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23   <u>Claim 6</u>

24   In response to the arguments presented in the Third Appeal Brief as to claim 6, the

25   Examiner initially asserted the following in the paragraph spanning pages 10 and 11 of the

26   Examiner's Answer:

27   Appellant argues — Regarding claim 6, Knight does not teach "messages are posted to
28   (and requested from) selected topics and that a request processor coverts (sic) requests to post and
29   retrieve messages to and from individual ones of the selected topics into requests to and from
30   associated subtopics." The appellant provides no support for this argument other than a statement
31   disclosing that Knight does not teach the limitation. The appellant's arguments fail to comply with
32   37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable
33   invention without specifically pointing out how the language of the claims patentably
34   distinguishes them from the references.
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1   Yet again, the Examiner's response is specious. The Examiner cites to the initial sentence of

2   Appellant's argument and then asserts that Appellant has failed to comply with 37 C.F.R. §

3   1.111(b) while <u>ignoring</u> the subsequent arguments presented in the same and following

4   paragraphs, which further describe the deficiencies in the Examiner's analysis.

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6   The Examiner then asserted the following:

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> The examiner points to lines 18-30 of column 12 in Knight which disclose: "In other words, unlike the prior art, which only indexes the text of messages usually for later search retrieval, the present invention also intelligently classifies and stores messages by subject matter area/class/subclass in advance based on understanding the context of the posting. For example, if a user responds with a reply posting to an original posting in a particular subject matter area, the present invention tags the reply posting with a parameter field specifying that the reply posting should also be classified in the same area as the original posting. Other potential classifications/subclassifications can be given to messages depending on logical inferences that can be drawn from their substance." It is clear from this recitation that the system of Knight performs the exact limitation the appellant argues. In Knight, the requests to post and retrieve messages are intelligently classified and stored by area/class/subclass based on understanding the context. Therefore, the system does teach the argued limitation.

20   Notwithstanding the Examiner's <u>newly cited</u> passage, the Examiner has still failed to establish

21   that Knight identically discloses the claimed limitations.

22

23   As claimed, <u>requests</u> are <u>converted</u>. Specifically, requests to post and retrieve messages

24   to and from individual ones of the selected topics are converted into message system requests to

25   post and retrieve messages to and from associated subtopics. On the contrary, Knight is silent as

26   to converting requests. Instead, Knight teaches taking a message and "intelligently [classifying]

27   and [storing] the messages by subject matter area/class/subclass." Also, Knight teaches that a

28   response to the original message is also "classified in the same area as the original posting."

29   Absent from these cited teachings are any mention of converting requests to post and retrieve

30   messages. Thus, the Examiner has failed to establish that Knight identically discloses the

31   claimed invention, as recited in claim 6, within the meaning of 35 U.S.C. § 102.

For the reasons set forth in the Third Appeal Brief and for those set forth herein, Appellant respectfully solicits the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. §§ 102, 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: September 10, 2008   Respectfully submitted,

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